

*Attorney Docket No. 2185.004USU
(AUC-32815(1))*

Serial No. 10/695,429

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : MATHIEU, David, et al.
Serial No. : 10/695,429
For : Rotary Trimmer
Filed : October 28, 2003
Examiner : PAYER, Hwei Siu Chou
Group Art Unit : 3724

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CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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Date: April 7, 2005

Bernadette Jackson

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Dear Sir:

AMENDMENT AND RESPONSE TO OFFICE ACTION

In response to the Office Action mailed March 7, 2005 requiring the restriction of the claims, please amend the above-identified application as follows:

The Response to Restriction Requirements begins on page 2 of this paper.

Amendments to the Specification begin on page 6 of this paper.

Amendments to the Claims begin on page 7 of this paper.

Remarks begin on page 12 of this paper.

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RESPONSE TO RESTRICTION REQUIREMENTS

Group and Species Elections. The Examiner has subjected the claims to a two-way restriction. The Applicants elect without traverse the invention of Group I, i.e., Claims 1-32. Because the Applicants have elected the invention of Group I, they are also required to elect one of six species of the claimed invention which the Examiner identified in the Office Action as patentably distinct from one another. Accordingly, the Applicants elect *with traverse* Species II as shown in Fig. 19. The claims that read on this species are Claims 1-14, 16, 18, and 28-32.

Of the elected claims, 1-32, all remain as originally filed. Of the nonelected claims, Claims 33-36 have been cancelled without prejudice to their future prosecution in one or more divisional applications. Applicants have amended the claims to add new Claims 37 and 38.

Generic Claims. As the Examiner noted, "some claims are generic to Species I through IV." Applicants submit that Claims 1-13, 16, and 28-32 are generic to Species I through IV. Claims 28, 29, and 32 are generic to all Species I through VII. Applicants also have added new Claims 37 and 38, which also are generic to all Species I through VII.

Traversal. The Applicants traverse, and the Examiner is respectfully requested to reconsider and withdraw, the restriction requirement among Species I through VII.¹ There are three reasons for the traversal. First, Species I through VII all are directed to the same invention, with only immaterial differences that will not create an undue burden on the Examiner in conducting the required search. Second, the restriction requirement is improper because Species I through VII are not mutually exclusive. Third, and alternatively, Species I through IV are directed to a single species of invention, and Species VI and VII to another distinct species.

¹ The Examiner identified six species she viewed as "patentably distinct," labeling them as Species I, II, III, IV, VI, and VII, however, the Examiner made no reference to a "Species V." Thus, although the species are numbered I through VII (omitting Species V), the Office Action contains a six-way, not a seven-way, species restriction requirement. For purposes of this response, Applicants refer to the species as originally numbered by the Examiner in the Office Action.

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1. Species I through VII all are directed to the same invention with only immaterial differences that will not create an undue burden on the required search.

First, Species I through VII all are directed to a rotary trimmer having one or more cutting blades and a blade carriage for carrying the cutting blades, which has a connector for connecting the blade carriage to different tools. The differences between the Species are not material, and pertain largely to the tools to which the blade carriage is connected, but not to the principle of operation.

2. The restriction requirement is improper because Species I through VII are not mutually exclusive.

The amendments to add Claims 37 and 38, which are generic to all six species, make clear that the six Species are not mutually exclusive, as required for a proper species restriction. See MPEP § 806.04(f) ("Claims to be restricted to different species must be mutually exclusive."). Each species, as shown in the corresponding figures, includes one or more cutting blades and a blade carriage that has a connector enabling the blade carriage to be selectively and operatively connected to different tools. The immaterial differences between each species do not make them mutually exclusive from one another.

Moreover, Species II (Fig. 19), III (Fig. 20), and IV (Fig. 22) are not mutually exclusive, as required for a proper species restriction. See MPEP § 806.04(f) ("Claims to be restricted to different species must be mutually exclusive."). The embodiments which the Examiner viewed as separate species, Figures 19, 20, and 22, are *not* mutually exclusive. They all show a rotary cutter with a rail connected to the cutting board at two aligned pivot points. These Figures simply are *different views of the same embodiment*. Fig. 19 shows a removable cutting board resting in place. Fig. 20 is a perspective view of the embodiment of Fig. 19, showing a removable cutting board removed from the rotary trimmer. Figs. 21 and 22 are also perspective views of the embodiment of Fig. 19 showing different views of this device. These are not distinct inventions that are mutually exclusive; a removable cutting board may be lifted from or rest upon the rotary trimmer. These figures simply are different views of the same embodiment of the claimed invention. Applicants have amended the Specification to clarify that these figures

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depict the same embodiment. All of the claims that read on these Species (Claims 1-13, 16, and 28-32) claim rotary trimmers that apply the same principle of operation and are not distinct.

Species VI (Fig. 4) and VII (Figs. 11-14) also are not distinct inventions and should not be restricted because they too are not mutually exclusive. See MPEP § 806.04(f). The claims demonstrate that the species are not exclusive. Claim 28, for example, claims the rotary trimmer of Claim 19 (which is depicted in Figs. 4, 13, and 14), which has a connector that enables the blade carriage “to be selectively and operatively connected to different tools.” An example of one such “different tool” is the rotary trimmer shown in two different views in Figs. 11 and 12. Thus, Species VI (Fig. 4) and Species VII (Figs. 11-14) are not at all mutually exclusive, but instead demonstrate an element of the claims, that the “blade carriage [can] be selectively and operatively connected to different tools.”

3. Species I through IV are directed to a single species of invention, and Species VI and VII to another distinct species.

Alternatively, Species I through IV all are directed to a first species of rotary trimmer having one or more cutting blades, a cutting board, a blade carriage, and a rail, as described in Claims 1-18, while Species VI and VII are directed to a second species of rotary trimmer with a blade carriage with a connector enabling said blade carriage to be selectively and operatively connected to different tools.

As to Species I through IV, the differences between the species are not material, and pertain largely to the manner in which the rail is connected to the cutting board, and how the cutting board is attached to the rotary trimmer. To this effect, dependent Claims 14 and 15 distinguish between a rail that is pivotally connected at a *single point* and at *two aligned pivot points*, respectively—but both of these claims require a rail pivotally connected to the cutting board. This is supported by the Specification, at page 13 and lines 1-17. Dependent Claims 16, 17, and 18 distinguish between rotary trimmers with cutting boards having one or more storage compartments, cutting boards having interchangeable cutting surfaces, and cutting boards which are foldable, respectively. All three of these claims require a rotary trimmer with a cutting board. This is further explained in the Specification, at page 13 and lines 19-26 and page 14, lines 1-8. The distinctions between the Species I through IV are immaterial, as they vary only in *how* the

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rail is pivotally attached to the cutting board, and how the cutting board connects to the trimmer as a whole, and do not affect the invention's principle of operation.

As to Species VI and VII, the differences also are not material, as the embodiments shown in Figs. 4 (Species VI) and Figs. 11-14 (Species VII) each show a rotary trimmer with a blade carriage with a connector enabling the blade carriage to be selectively and operatively connected to different tools. The different tools may be a tool with an elongated handle, as in Figs. 4 and 14, or a tool with a rail, as shown in Fig. 11.

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